



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Docket No.: SCHALLER

*new serial #10766435*

In re Application of:	)
HEINZ SCHALLER et al. <sup>1</sup>	)
Appl. No.: 09/383,978	)
Filed: August 26, 1999	)
For: METHODS AND COMPOSITIONS FOR	)
EXPRESSING HETEROLOGOUS	)
GENES IN HEPATOCYTES USING	)
HEPADNAVIRAL VECTORS	)
Exam: Quang Ngyuen	)
Group Art Unit: 1632	)

**RESPONSE TO NOTICE OF OMITTED ITEMS IN A NON-PROVISIONAL  
APPLICATION AND PETITION TO GRANT A FILING DATE TO ALL PARTS  
OF THE APPLICATION**

Mail Stop Missing Parts  
Commissioner for Patents  
Washington, D.C. 20231

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231, on **AUGUST 3, 2004.**  
(Date)

**URSULA B. DAY**

(Name of Registered Representative)

*Ursula B. Day*  
Signature

*Aug 3, 2004*  
Date of Signature

SIR:

In response to the Notice of Omitted Items in a Non-Provisional Application ("Notice"), applicant hereby petitions the Commissioner pursuant to Rule 1.53, that at the filing date of January 27, 2004, the entire application was before the Office.

As grounds for the petition applicant submits the following:

Facts:

The above-identified application was filed on January 27, 2004, as a continuation application based on the parent application Serial Number 09/383,978.

The application was filed with a total of 43 pages made up of 30 pages of specification, 5 pages of claims, 1 page of abstract and 7 pages of Figures 1-7.

In addition, the prior declaration, IDS and new power of attorney were also enclosed.

On June 23, 2004 the Notice having a mailing date of June 21, 2004, was received by the undersigned.

The Notice indicated that page 28 of the specification was missing from the application papers.

In support of a showing that the application papers were complete when filed, a copy of the postcard indicating that 36 pages of specification were filed, is submitted herewith.

As further evidence that all pages of the specification were before the Office, applicant also submits the cover page of the application papers as filed in which it is explicitly stated that the entire prior parent application is incorporated by reference into the present continuation application.

Applicant submits that the evidence shows page 28 was before the Office at the filing date of January 27, 2004.

In support of applicant's petition the following items are submitted herewith:

1. a copy of the Notice,
2. a copy of page 28 of the specification,
3. the post card received and stamped by the Office; and
4. the copy of the cover sheet submitted for filing the application.

Relief Sought:

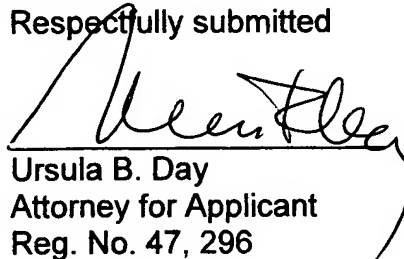
In view of the facts as set forth above, it is respectfully requested that the Commissioner:

1. Grants applicant a filing date based on the entire specification of the application including page 28 as filed.
2. Accepts this petition, but reimburses applicant the fee for this petition since the Patent Office received all of the specification.

The Commissioner is hereby authorized to charge the petitions fee of \$130.00 pursuant to 37 CFR 1.17(h) and any additional fees which may be required, or credit any overpayment to Deposit Account No.: 50-1747.

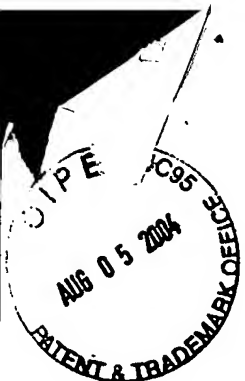
Respectfully submitted

By:

  
Ursula B. Day  
Attorney for Applicant  
Reg. No. 47, 296

Date: August 3, 2002  
350 Fifth Avenue  
Suite 4714  
New York, N.Y. 10118  
(212) 244-5500  
UBD:sh

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No: SCHALLER 2/1  
Anticipated Classification of this  
application: Class:  
Prior Appl(s). No: 09/383,978  
Examiner: QUANG NGUYEN  
Art Unit: 1636

Mail Stop Patent Application  
Commissioner for Patents  
Alexandria, VA 22313-1450

Express Mail mailing label number: <u>EV 323204518615</u>	
Date of Deposit: <u>Jan. 27, 2004</u>	
I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450".	
<u>William B. Day</u> [Name of person mailing paper or fee]	
<u>[Signature]</u> [Signature]	

SIR:

This is a request for filing a ☐ Continuation-In-Part, ☒ Continuation, or  
☐ Divisional application under 37 C.F.R. 1.53(b) of pending prior applications of:

Inventor(s): HEINZ SCHALLER ET AL.

Appl. No(s): 09/383,978

filed: August 26, 1999

for: METHOD AND COMPOSITIONS FOR EXPRESSING  
HETEROLOGOUS GENES IN HEPATOCYTES USING  
HEPADNAVIRAL VECTORS

1. ☒ Enclosed is a specification, together with a  
☒ Copy of the oath or declaration as originally filed, or  
☐ Original or copy of a newly executed oath or declaration.
2. ☒ The entire disclosure of the prior application, from which a copy of the  
oath or declaration is supplied, is considered as being part of the  
disclosure of the accompanying application and is hereby incorporated  
by reference therein.
3. ☐ A new oath or declaration is included since this application is a  
continuation-in-part which discloses and claims additional matter.

# PATENT

4. ☐ This application is filed by fewer than all the inventors named in the prior application, 37 C.F.R. 1.53(d)(4).  
☐ **DELETE** the following inventor(s) named in the prior nonprovisional application:  
☐ The inventor(s) to be deleted are set forth on a separate sheet attached hereto.
5. ☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27  
☒ was not filed in the prior application, but applicants claims small entity status, and the application was never assigned.  
☐ is enclosed, or  
☐ was claimed in the prior application no. 09/831,256 and such status is still proper and desired (37 C.F.R. 1.28(a)), or  
☐ is no longer claimed.
6. ☐ Enter the amendment previously filed on \_\_\_\_\_ under 37 C.F.R. 1.116 but unentered, in the prior application.
7. ☐ A preliminary amendment is enclosed.
8. ☐ The filing fee is calculated on the basis of the claims existing in the prior application as amended

Basic fee for the above application:	\$ 770.00
Total number of claims 20-20	\$
Independent claims 3-3	\$
Reduction by 50% for filing by a small entity	\$ 385.00
Total filing fee:	\$ 385.00

9. ☒ A check in the amount of \$375.00 is enclosed.
10. ☐ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Account No. 50-1747. A duplicate copy of this sheet is enclosed.
11. ☒ Cancel in this application original claims of the prior application before calculating the filing fee.
12. ☐ Amend the specification by inserting before the first line the sentence:--  
This is a  
☐ continuation-in-part  
☒ continuation

☐ division  
of pending patent application Appl. No. 09/383,987, filed August 26, 1999

13. ☐ New formal drawings.

14. ☐ Priority of application Appl. No. filed in \_\_\_\_\_, and priority of International Appl. No. PCT/ \_\_\_\_\_, filed \_\_\_\_\_, are claimed under 35 U.S.C. 119(a)-(d).

☐ The certified copy has been filed in prior patent application Appl. No. \_\_\_\_\_, filed \_\_\_\_\_.

15. ☐ An Information Disclosure Statement (IDS)

☐ PTO Form 1449

☐ Copies of IDS Citations

☒ Copies of PTO Forms 1449 as filed by applicant during prosecution of parent application 09/383,978, and of PTO Forms 892, as cited by the Examiner during prosecution of parent application 09/383,978.

☐ Copies of IDS Citations

16. ☐ Priority of application is assigned of record to:

17. ☐ A new Assignment

☐ Cover Sheet under 37 C.F.R. 3.73(b)

18. ☒ The power of attorney in the prior application is to:

**Ursula B. Day**  
**350 Fifth Avenue, Suite 4714**  
**New York, N.Y. 10118.**

a. ☒ The power appears in the papers in the prior application.

b. ☒ Address all future communications to:

**URSULA B. DAY**  
**Customer No. 28157**

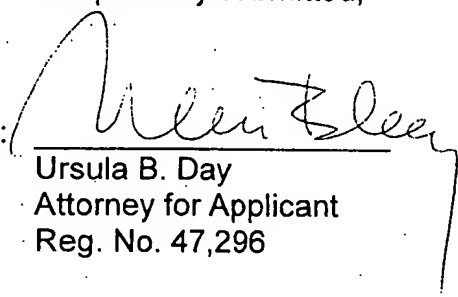
# PATENT

## 19. ☐ EXTENSION OF TERM

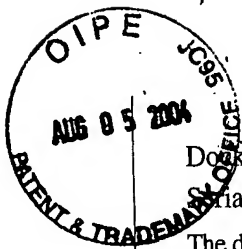
- a. ☒ The Commissioner is hereby petitioned to extend the period for response to Official Action, dated in the prior patent application, Appl. No: 09/383,978, filed August 26, 1999, by TWO months until January 27, 2004. Accompanying this communication is the appropriate fee of \$ 210.00 pursuant to 37 C.F.R. §1.17(c) and 37 C.F.R. §1.136(a).
- b. ☐ A separate paper directed to the prior patent application, Appl. No. , filed
- c. ☐ Request for Extension of Time was filed on together with a Request for Reconsideration, and the appropriate fee of was paid.

Respectfully submitted,

By:

  
Ursula B. Day  
Attorney for Applicant  
Reg. No. 47,296

Date: January 27, 2004  
350 Fifth Avenue  
Suite 4714  
New York, N.Y. 10118  
(212) 244-5500  
UBD:sh



Docket No. 69/383 978  
Serial/Patent No. Schaller

The date stamp of the Patent & Trademark Office hereon confirms the date the following was received.

☒ Continuation 36pp. 7 drawings  
☒ New Application

☒ Filing Date January 27, 2004

☐ Assignment

☐ Drawing

☐ Notice of Appeal

☐ Appeal Brief

☒ Power of Att.

☒ Fee

☐ Resp. to O.A.

☐ Con. Doc.

☒ Check No. #11454146 for cont. fee \$ 385.00

No. 9012 Patent receipt card, 9-02

19270 U.S. PTO  
10/766435



012704

PTO: Please stamp and return.

☒ IDS + Suppl. IDS  
☒ 2 declarations  
☒ Pet. for Ext. Time  
☒ Transmitted

Ext. fee 210.00 2002 by Blumberg Excelsior, Inc. 800 221-2972 [www.blumberg.com](http://www.blumberg.com)

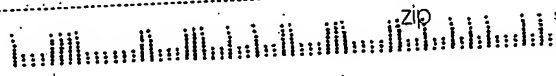
UNITED STATES POSTAGE  
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0412 NEW YORK, NY 10116

Affix  
First  
Class  
Postage

RECEIVED  
FEB 6 2004  
HENRY M. FEIEREISEN, LLC

URSULA B. DAY, ESQ.  
350 FIFTH AVENUE, SUITE 4714  
NEW YORK, N.Y. 10118

10118/4704







UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER \
10/766,435	01/27/2004	Heinz Schaller	SCHALLER 2/1

CONFIRMATION NO. 4011

28157  
URSULA B. DAY, ESQ.  
350 FIFTH AVE.  
SUITE 3220  
NEW YORK, NY 10118

FORMALITIES LETTER



\*OC000000013007782\*

Date Mailed: 06/21/2004

NOTICE OF OMITTED ITEM(S) IN A NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

A filing date has been accorded to the above-identified nonprovisional application papers; however, the following item(s) appear to have been omitted from the application:

- Page(s) 28 of the specification (description and claims).

I. Should applicant contend that the above-noted omitted item(s) was in fact deposited in the U.S. Patent and Trademark Office (USPTO) with the nonprovisional application papers, a copy of this Notice and a petition (and \$130.00 petition fee (37 CFR 1.17(h))) with evidence of such deposit **must** be filed within **TWO MONTHS** of the date of this Notice. The petition fee will be refunded if it is determined that the item(s) was received by the USPTO.

II. Should applicant desire to supply the omitted item(s) and accept the date that such omitted item(s) was filed in the USPTO as the filing date of the above-identified application, a copy of this Notice, the omitted item(s) (with a supplemental oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items), and a petition under 37 CFR 1.182 (with the \$130.00 petition fee (37 CFR 1.17(h))) requesting the later filing date **must** be filed within **TWO MONTHS** of the date of this Notice.

Applicant is advised that generally the filing fee required for an application is the filing fee in effect on the filing date accorded the application and that payment of the requisite basic filing fee on a date later than the filing date of the application requires payment of a surcharge (37 CFR 1.16(e)). To avoid processing delays and payment of a surcharge, applicant should submit any balance due for the requisite filing fee based on the later filing date being requested when submitting the omitted items(s) and the petition (and petition fee) requesting the later filing date.

III. The failure to file a petition (and petition fee) under the above options (I) or (II) within **TWO MONTHS** of the date of this Notice (37 CFR 1.181(f)) will be treated as a constructive acceptance by the applicant of the application as deposited in the USPTO. **THIS TWO MONTH PERIOD IS NOT EXTENDABLE UNDER 37 CFR 1.136(a) or (b).** In the absence of a timely filed petition in reply to this Notice, the application will maintain a filing date as of the date of deposit of the application papers in the USPTO, and original application papers (*i.e.*, the original disclosure of the invention) will include only those application papers present in the USPTO on the date of deposit.

In the event that applicant elects not to take action pursuant to options (I) or (II) above (thereby constructively electing option (III)), amendment of the specification to renumber the pages consecutively and cancel incomplete sentences caused by any omitted page(s), and/or amendment of the specification to cancel all references to any

omitted drawing(s), relabel the drawing figures to be numbered consecutively (if necessary), and correct the references in the specification to the drawing figures to correspond with any relabeled drawing figures, is required. A copy of the drawing figures showing the proposed changes in red ink should accompany with any drawing changes. Such amendment and/or correction to the drawing figures, if necessary, should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application.

Replies should be mailed to: Mail Stop Missing Parts  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

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*A copy of this notice **MUST** be returned with the reply.*

UTB:oe  
Customer/Service Center  
Initial Patent Examination Division (703) 308-1202

PART I - ATTORNEY/APPLICANT COPY